



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/026,336 | 02/19/1998 | MASAHIDE TANAKA | 06205.0007 | 1637 |

22930 7590 12/05/2002

HOWREY SIMON ARNOLD & WHITE LLP
BOX 34
1299 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

| |
|----------|
| EXAMINER |
|----------|

VU, NGOC YEN T

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2612

DATE MAILED: 12/05/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/026,336

Applicant(s)
Masahide TANAKA et al.

Examiner
Ngoc-Yen Vu

Art Unit
2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 19, 1998.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 19, 1998 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 4 6) ☐ Other:

Art Unit: 2612

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statements, filed 02/19/1998 and 07/16/2002, have been placed in the application file, and the information referred to therein has been considered.

Claim Objections

3. Claims 1-6, 8, 11, 13 and 16 -18 are objected to because of the following informalities:

Claim 1: line 3, it is suggested that the “receiving means” is changed to “transmitting means” since its function is transmitting the electromagnetic signal to a remote device; line 12, change “the still image” to --*a* still image--.

Claim 2: line 1, claim 2 is currently depending on claim 2. Correction is required. For the purpose of art rejection, the Examiner will presume claim 2 depends on claim 1.

Claim 3: line 2, change “the digital image” to --the *still* image--.

Claim 4: line 4, insert --signal-- after “electromagnetic”; line 8, change “electronic signal” to --electronic *image* signal--.

Claim 5: lines 2 and 4, insert --said-- before “electromagnetic signal”.

Claim 6: lines 2 and 4, insert --said-- before “electromagnetic signal”.

Art Unit: 2612

Claim 8: line 3, insert --said-- before “electromagnetic signal”.

Claim 11: line 4, change “the electromagnetic signal” to --*an* electromagnetic signal--; line 7, change “the still image” to --*a* still image--.

Claim 13: line 2, insert --*image*-- before “signal”; line 3, insert --*electronic*-- before “image signal”.

Claim 16: line 3, insert --*image*-- before “signal”.

Claim 17: line 2, insert --*image*-- before “signal”.

Claim 18: line 3, change “electronic signal” to --electronic *image* signal--; line 5, change “a still image” to --*the* still image--; line 5, insert --*image*-- before “signal”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 12 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “electromagnetic signal” in lines 10 and 14. Claim 1 recites two different electromagnetic signals, one signal to be transmitted to a remote device and one signal to be

Art Unit: 2612

received from the remote device. It is not clear which electromagnetic signal the claim refers to in lines 10 and 14.

Claims 2-3 are rejected for being depending on the rejected claim 1.

Claim 12 recites the limitation "the converting means" in lines 2-3. There is no antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the converting means" in line 3. There is no antecedent basis for this limitation in the claim.

Claim 19 recites "the modifying means" in line 2, it is unclear which modifying means claim 19 refers to because there is modifying means recited in the independent claim 11 and second means for modifying recited in the dependent claim 18. Correction is required.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2612

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US #6,009,336) in view of Brusewitz et al. (US #6,038,257).

Regarding claims 1 and 3, Harris '336 teaches a digital still camera comprising means for converting an optical image into a digital image signal (Fig. 1, CCD camera 188); receiving means (RF transceiver 126) for transmitting an electromagnetic signal to a designated remote device accessible in accordance with a wireless telephone system; means for receiving (RF transceiver 126) from said remote device an electromagnetic signal containing an identification signal to be transmitted back in response to the designation of said remote device (col. 2 line 55 - col. 12 line 37); modifying means (DSP 128 & DSP 152) for modifying the electromagnetic signal into a digital electronic signal (col. 2 line 55 - col. 12 line 37); and means for transmitting (RF transceiver 126) the electromagnetic signal to the designated remote device (col. 2 line 55 - col. 12 line 37). Claim 1 differs from Harris in that the claim further requires reducing means for reducing the number of pixels of the still image represented by said digital electronic image signal. However, it is well known in the art that a high resolution image is reduced to a low resolution image for the purpose of viewing an interested portion of the high resolution image or reducing

Art Unit: 2612

the transmission time and bandwidth of the image, as taught in Brusewitz (Figs. 1-3, device 8; see also col. 2 line 54 - col. 8 line 12). In light of the teaching from Brusewitz, it would have been obvious to one of ordinary skill in the art to modify the digital hand held imaging device taught in Harris by providing a reducing means for reducing the number of pixels of a still image so as to shorten the displaying time while reducing the transmission time and bandwidth.

As to claim 2, Harris teaches that the DSP 128 and DSP 152 form a digital image signal without reducing the number of pixels. Although Harris, as modified by Brusewitz, does not explicitly teach that the reducing means is inoperative when the receiving means fails to receive the identification signal transmitted from the remote device, it would have been obvious to one of ordinary skill in the art to recognize that low resolution images are not needed if there is no reception of a call from a remote device.

Regarding claims 4-19, the subject matter in these claims can be found in claims 1-3. It is noted that Harris, as modified by Brusewitz, teaches displaying means (Fig. 1, display 184) for alternatively displaying a still image having high resolution or low resolution as desired by the user of the hand-held imaging device.

Conclusion

6. **Any response to this office action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Art Unit: 2612

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,
Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ngoc-Yen Vu** whose telephone number is (703) 305-4946. The examiner can normally be reached on Mon. - Fri. from 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (703) 306-0377.

NYV
12/02/2002


NGOC-YEN VU
PRIMARY EXAMINER